

USSN 09/769,128
Art Unit 1742
Amendment

Docket No. M6691

REMARKS

Entry of the foregoing amendments to the claims is respectfully requested.

New claim 21 corresponds to original claim 4 in independent form. In new claim 21, subpart (a) comes from claim 1; subparts (b)-(d), and (f) come from claim 4; and subpart (e) comes from claim 3.

New claim 23 corresponds to original claim 5 in independent form. In new claim 23 subpart (a) comes from claim 1; subparts (b)-(d), (f) and (g) come from original claim 5; and subpart (e) comes from original claim 3.

Rejection Under 35 USC §102(b)

Claims 1 and 2 are rejected under 35 USC §102(b) as being anticipated by Endo et al. (US 5,232,523). Applicant respectfully requests reconsideration and withdrawal of this rejection in view of the cancellation of claims 1 and 2.

This rejection is deemed moot because new claims 21 and 22 do not include the inorganic oxides included in original claims 1 and 2.

For this reason, withdrawal of the rejection under 35 USC §102(b) for anticipation by Endo et al. is respectfully solicited.

Rejection Under 35 USC §103(a)

Claims 3-5 are rejected under 35 USC §103(a) as being obvious over Endo et al. in view of the applicant supplied translation of WO 97/45568. Applicants respectfully request reconsideration and withdrawal of this rejection with respect to new claims 21 and 22 for the reasons presented below.

As noted above and by the examiner, the compositions of Endo et al. include the inorganic oxides but not the film-forming polymers or amino-phenolic polymers of applicants' original claims 1-5 and new claims 21 and 22. Therefore, the disclosure of WO 97/45568 is believed to be more relevant than that of Endo et al. to the invention as presently claimed in claims 21 and 22.

New claim 21 is drawn to liquid compositions including particularly selected amino-phenolic polymers and calcium ions. New claim 21 includes characteristics of said selected amino-phenolic polymers that are not described in WO 97/45568. Applicants submit that such

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selection characteristics are neither taught in or obvious from the disclosure of WO 97/45568. Only applicants have done the experimentation necessary to arrive at the amino-phenolic polymers having the claimed characteristics. The skilled person cannot "inherently" arrive at applicants' selected amino-phenolic polymers by applying any particular criteria stated in WO 97/45568.

Further, Claim 21 includes calcium ions. Although WO 97/45568 discloses that its compositions may include up to 2.5 g/l of calcium ions, neither the examples nor claims show the inclusion of calcium ions as a preferred component. Nor, is there any teaching that calcium ions are particularly useful with one or the other types of polymers disclosed therein. Again, only the present applicants have done the experimentation necessary to demonstrate the usefulness of calcium ions with the particularly characterized amino-phenolic polymers.

For these reasons, applicants respectfully submit that new claim 21 is patentable over Endo et al. and WO/45568.

New claim 22 is drawn to liquid compositions including particularly selected film-forming acrylic polymers. New claim 21 includes characteristics of said selected film-forming acrylic polymers that are not described in WO 97/45568. Applicants submit that such selection characteristics are neither taught in or obvious from the disclosure of WO 97/45568. Only applicants have done the experimentation necessary to arrive at the acrylic polymers having the claimed selection characteristics. The skilled person cannot "inherently" arrive at applicants' selected acrylic polymers by applying any particular criteria stated in WO 97/45568.

For these reasons, applicants respectfully submit that new claim 22 is patentable over Endo et al. and WO/45568.

Allowance of the application as amended herein is respectfully solicited.

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Respectfully submitted,

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